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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,574	08/01/2001	William R. Bullman	P-25, 174 USA	4236

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EXAMINER

NGUYEN, VAN KIM T

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,574

Applicant(s)

BULLMAN ET AL.

Examiner

Van Kim T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 11-13 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 4-10, 14-17, and 21-23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This Office Action is responsive to communications filed on July 22, 2005.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Claims 1-3, 11-13, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Booth (US 6,065,073).

Regarding claims 1, 11, and 18, as shown in Figures 11-14, Booth discloses a system (200) comprising:

an extended protocol layer (a layer comprises a chosen communication protocol layer, since the NIC is configured to switch dynamically between different network interface and thus capable of receiving network data and converting the received data into a format applicable to the chosen communication protocol, col. 9: lines 50-55, and col. 10: lines 22-34) for generating an access command packet, the access command packet *being encapsulated in a standardized data packet* and containing an access command (since the NIC of computer system 200 can perform on-the-fly switching between a first network interface and a second network interface, inherently the access command write or read must be encapsulated (i.e., carrying frames/packets of one protocol as data in another) in some standardized data packet; col. 9: lines 50-64) to access the at least one designated register (942, 944) of the PHY device (940); and

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the PHY device (940), including the at least one designated register (942, 944) , for receiving the access command packet and executing (write or read) the access command of the access command packet (col. 18: lines 38 – col. 19: lines 44).

Regarding claims 2, 12, and 19, Booth also discloses wherein the access command of the access command packet is a register read command for instructing the PHY device to read content stored in the at least one designated register of the PHY device (col. 19: lines 20-28), or is a register write command for instructing the PHY device to write certain data (control value) into the at least one designated register of the PHY device (col. 19: lines 9-15).

Regarding claims 3, 13, and 20, Booth also discloses when the access command of the access command packet is a register write command, the access command packet contains the certain data to be written into the at least one designated register of the PHY device (col. 19: lines 9-15).

Allowable Subject Matter

3. Claims 4-10, 14-17, and 21-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

See Previous Office Action for Reason for Allowance.

Response to Arguments

4. Applicant's arguments filed July 22, 2005 have been fully considered but they are not persuasive. However, the examiner would like to register her appreciation of Applicant's thorough explanation of the claimed invention.

In response to applicant's argument that "*Booth is silent as the element of claim 1 of an extended protocol layer which generates an access command packet, encapsulated in a standardized data packet, and uses that command packet to access a register of a PHY device*", page 10: lines 19-21), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

As shown above, Booth discloses an extended protocol layer (a layer comprises a chosen communication protocol layer, since the NIC is configured to switch dynamically between different network interface and thus capable of receiving network data and converting the received data into a format applicable to the chosen communication protocol, col. 9: lines 50-55, and col. 10: lines 22-34) for generating an access command packet, the access command packet *being encapsulated in a standardized data packet* and containing an access command (since the NIC of computer system 200 can perform on-the-fly switching between a first network

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interface and a second network interface, inherently the access command write or read must be encapsulated (i.e., carrying frames/packets of one protocol as data in another) in some standardized data packet; col. 9: lines 50-64) to access the at least one designated register (942, 944) of the PHY device (940).

Granted, Booth's extended protocol layer may be "(a) management interface (which) is defined by IEEE standards", but since Booth discloses a structure is capable of performing the intended use, i.e., *an extended protocol layer which generates an access command packet, encapsulated in a standardized data packet, and uses that command packet to access a register of a PHY device*, it meets the claims.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *not using the industry-standard procedure to perform access to PHY devices*, page 11: lines 1-2) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Van Kim T. Nguyen whose telephone number is 571-272-3073. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung, can be reached on 571-272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Van Kim T. Nguyen
Examiner
Art Unit 2151

vkkn


ZARNI MAUNG
SUPERVISORY PATENT EXAMINER